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JOHN H THOMAS
536 GRANITE AVENUE
RICHMOND, VA 23226

EXAMINER

CAJILIG, CHRISTINE T

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/798,779

Applicant(s)

FILIPPI, DAVID G.

Examiner

Christine T. Cajilig

Art Unit

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-79 is/are pending in the application.
- 4a) Of the above claim(s) 39-41, 64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 42-63 and 65-79 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/23/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of the specie of Group 2 (Figures 5-7) in the reply filed on 5/17/06 is acknowledged. The traversal is on the ground(s) that Groups 1-7 (Figures 2-12) are not dependent or distinct from each other as per MPEP § 802.01 and that there is no serious burden on the examiner as per MPEP § 808.02 in order to require the restriction. This argument for Groups 1-7 (Figures 2-12) is not found persuasive because MPEP §§ 802.01 and 808.02 are directed toward inventions and not species of the invention, and that there would be a serious burden to examine to search for all the species. However, Applicant's argument that the species of Groups 2-7 (Figures 5-12) are not patentable over each other is acknowledged. Applicant's express admission on page 4 of the Restriction Requirement Response that Groups 2-7 (Figures 5-12) are obvious over each other within the meaning of 35 U.S.C 103 is persuasive. Thus a restriction over Groups 2-7 is hereby withdrawn. Groups 2-7, claims 42-63 and 65-79 are to be examined.

Claims 39-41 and 64 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected specie of Group 1 (Figures 2-4), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 5/17/06.

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:
It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or supplemental oath or declaration.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "90" and "102" have both been used to designate the fourth wall on Figure 7. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: "Lip" on page 3, lines 15 and 25 should not be capitalized; There is no point 39 on stop 36 on Figure 2

as stated on page 4, line 6; 90 is used to designate both the wall and the slot on the last paragraph of page 5.

Appropriate correction is required.

Claim Objections

The claims 42-47, 52-53, 58-60, 63, 65-66, 68-69, 71-73, and 75-79 are objected to because they include reference characters, which are not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

Claim 68 is further objected to because it states that the hinge width is "D2" when the hinge width has been designated as D3 in previous claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 55, and, accordingly, dependent claim 56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification and the drawings show that the third and fourth jaws are parallel to a horizontal portion of the third gutter wall. Furthermore, the last paragraph of page 5, continued on to page 6 states that it is slot 90, which are formed by the vertical walls 94 and 102, that receive the vertical portion of the gutter. Therefore, the third and fourth jaws cannot be parallel to the vertical wall of the gutter if the jaws are perpendicular to walls 94 and 102, which are parallel to the vertical wall of the gutter. For purposes of examination, the Examiner interprets "vertical gutter wall" as a "gutter wall."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 42-79 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 42, 63, 65, and 66, the language of "a solid sheet having one longitudinal edge thereof formed into a curl and wherein the cover extends downwardly and outwardly from the lowermost edge of a roof" is indefinite because it is unclear whether

the solid sheet is the cover or if it is an element different than the cover. For purposes of examination, the Examiner interprets the cover to be constructed of the solid sheet.

Claim 43 is indefinite because it is unclear whether "having a width" in line 3 of the claim refers to the bending slot or to the hinge. For purposes of examination, the Examiner interprets the hinge as having a width.

Claims 44 and 45 recites the limitation "the thickness" in the first line of the claims. There is insufficient antecedent basis for this limitation in the claim. Furthermore, "D3" has been referred in the previous claim as "the width" (D3) of the hinge.

Claim 56 recites the limitation "said third wall" in the second line of the claim. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination, the Examiner interprets "said third wall" as "said third jaw" previously mentioned in the second line of the claim.

Claim 75 is indefinite because "a bending slot" in the first line of the claim is a double inclusion of "a bending slot" first mentioned in claim 63, and it is unclear whether it is referring to a new bending slot or to the bending slot previously mentioned in claim 63. For purposes of examination, the Examiner interprets a bending slot in claim 75 as same bending slot previously mentioned in claim 63.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 42, 55, 61-62, 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Stevens (U.S. Patent No. 6,735,907 B2).

Regarding claims 45 and 65, Stevens in Figures 2 and 3 discloses a gutter-cover system for spacing a wall (20, 22, 24) of a gutter (4) from a gutter cover (2) comprising a solid sheet (2) having one longitudinal edge thereof formed into a curl (12) and wherein the cover (2) extends downwardly and outwardly from the lowermost edge of a roof (8) so that said curl (12) extends downwardly toward said gutter (4); a gutter-cover clip (34) having a substantially flat body portion (a) inherently having a thickness; said body portion (a) comprising a first throat portion (36) having first (52) and second (38) jaws thereof and shaped so that said first throat (36) portion is adapted to engage said curl (12) of said cover (2); third (b) and fourth (e) jaws and a second throat (c) located therebetween, said second throat (c) being adapted to engage said wall (22, 24) of said gutter (4) between said third (b) and fourth (e) jaws; and, at least a first locking lever (d) adjacent said third jaw (b) and joined to said body (a) portion by a hinge (e), said first locking lever (d) being adapted to be bent at said hinge (e) to bring said third jaw (b) into a locking position against said gutter (4) as seen in Figure 2.

Regarding claim 55, Stevens in Figure 2 discloses a gutter-cover system wherein said clip (34) is adapted to lock onto a gutter wall portion (22) and wherein said third (b) and fourth (40) jaws are essentially parallel to said gutter wall (22).

Regarding claim 61, Stevens discloses a gutter-cover system wherein said body portion is comprised of a flat piece of metal that is inherently bendable (Col 5, Ln 45-48).

Regarding claim 62, Stevens in Figures 2 and 3 discloses a gutter-cover system wherein the deepest part (f) of said first throat (36) and the deepest part (g) of said second throat (c) lie essentially in a common plane.

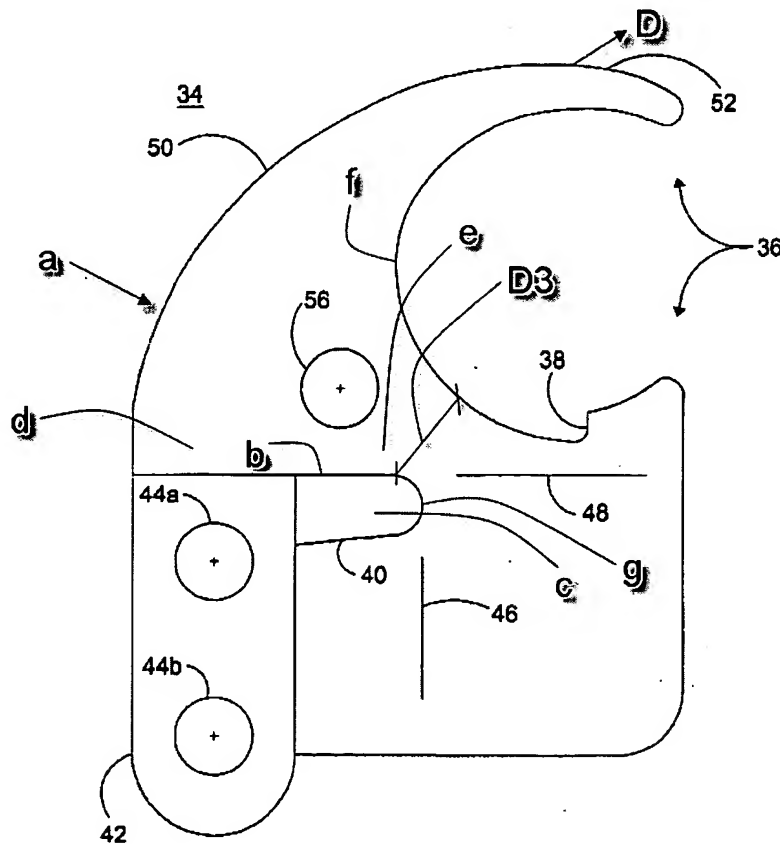


FIG. 3

Stevens (U.S. Patent No. 6,735,907 B2)

Claim Rejections - 35 USC § 103

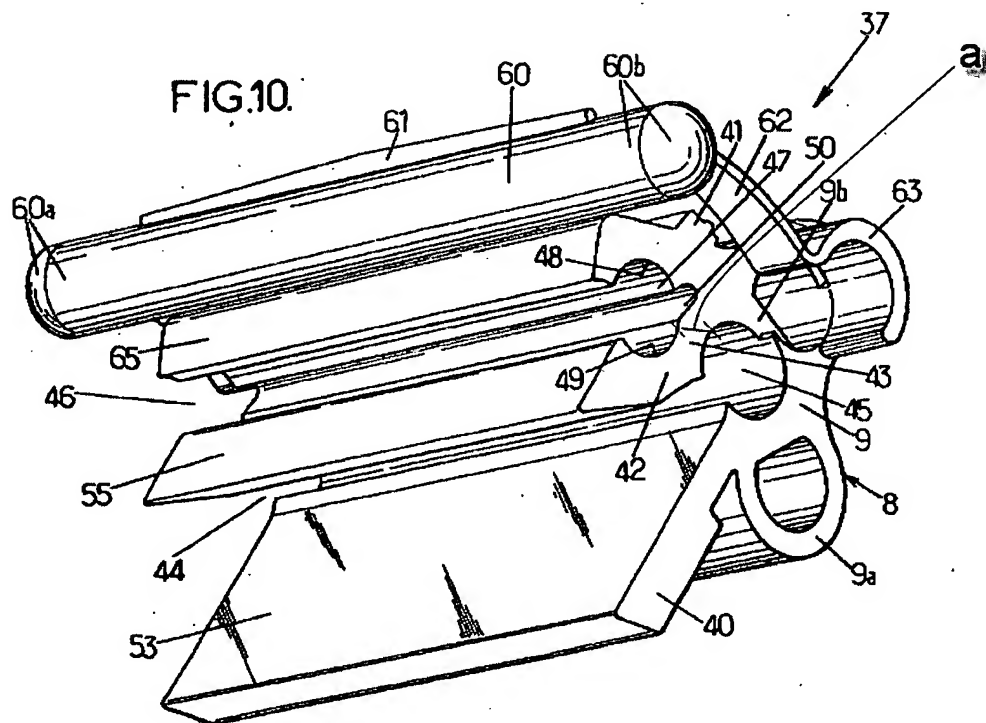
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43-48, 56, 63, 66-69, and 74-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Doussot et al. (U.S. Patent No. 5,426,832).

Regarding claim 43, Stevens discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system further including a bending slot in said body portion, said bending slot being located above said second throat so that said hinge is between said second throat and said bending slot and having a width (D3) whereby a force applied to said bending slot moves said locking lever about said hinge so that said third jaw is brought into locking engagement with said wall of said gutter. However, Doussot et al. in Figures 10 and 13 discloses a fixing clip including a bending slot (46) in a body portion (37), said bending slot (46) being located above a second throat (45) so that a hinge (43) is between said second throat (45) and said bending slot (46) and having a width (a) whereby a force applied to said bending slot (46) moves a locking lever (55) about said hinge (43) so that a third jaw (57) is brought into locking engagement with a rod (4). Stevens and Doussot et al. are analogous art because they are pertinent in the problem of securing a member via a clip. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the clip of Stevens to include a bending slot in said body portion,

said bending slot being located above said second throat so that said hinge is between said second throat and said bending slot and having a width (D3) whereby a force applied to said bending slot moves said locking lever about said hinge so that said third jaw is brought into locking engagement with said wall of said gutter as taught by Doussot et al. to further clamp down on an object that needs to be secured, in this case, the gutter wall (Col 10, Ln 3-17).



Doussot et al. (U.S. Patent No. 5,426,832)

Regarding claim 44 and 45, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the width of said hinge (D3) is between about 1/16 inch and 7/64 inch,

Art Unit: 3637

preferably about $3/32$ inch. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have the width of said hinge (D3) to be between about $1/16$ inch and $7/64$ inch, preferably about $3/32$ inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further or closer away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 46, 47, 68, and 69, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the ratio of the hinge width (D3) to the thickness (D) of said body portion is between about 0.25 and 1.2 inch, preferably about 0.94 inch. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have the ratio of the hinge width (D3) to the thickness (D) of said body portion is between about 0.25 and 1.2 inch, preferably about 0.94 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further or closer away from the front of the gutter wall while being able to support more length of the gutter cover. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 48, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above and further discloses a locking slot (56)

Art Unit: 3637

inherently capable of accommodating a locking-unlocking tool for selectively pivoting said locking lever (d) about said hinge (D3) and into a lock or unlocked position.

Regarding claim 56, Stevens discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system further including a bending slot in said body portion located adjacent said third jaw so that said hinge is between said third wall and said bending slot whereby a force applied to said bending slot moves said locking lever about said hinge so that said third jaw is brought into locking engagement with said wall of said gutter. However, Doussot et al. in Figures 10 and 13 discloses a fixing clip including a bending slot (46) in a body portion (37) located adjacent said third jaw (57) so that a hinge (43) is between said third jaw (57) and said bending slot (46) and having a width (a) whereby a force applied to said bending slot (46) moves a locking lever (55) about said hinge (43) so that a third jaw (57) is brought into locking engagement with a rod (4). Stevens and Doussot et al. are analogous art because they are pertinent in the problem of securing a member via a clip. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the clip of Stevens to include a bending slot in said body portion located adjacent said third jaw so that said hinge is between said third wall and said bending slot whereby a force applied to said bending slot moves said locking lever about said hinge so that said third jaw is brought into locking engagement with said wall of said gutter as taught by Doussot et al. to further clamp down on an object that needs to be secured, in this case, the gutter wall (Col 10, Ln 3-17).

Regarding claims 63 and 66, Stevens discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system further including a bending slot in said body portion located above said second throat and wherein the ratio of the distance between said first throat and said bending slot to the thickness of said hinge is between about 1.1 and 2.0. However, Doussot et al. in Figures 10 and 13 discloses a fixing clip including a bending slot (46) in a body portion (37), and said bending slot (46) being located above a second throat (45). Stevens and Doussot et al. are analogous art because they are pertinent in the problem of securing a member via a clip. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the clip of Stevens to include a bending slot in said body portion and said bending slot being located above said second throat as taught by Doussot et al. to further clamp down on an object that needs to be secured, in this case, the gutter wall (Col 10, Ln 3-17). Furthermore, it would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have the ratio of the distance between said first throat and said bending slot to the thickness of said hinge to be between about 1.1 and 2.0, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 67, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein said ratio of the distance between said first throat and said bending slot to the thickness of said hinge is preferably about 1.5. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have the ratio of the distance between said first throat and said bending slot to the thickness of said hinge to be preferably about 1.5, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 74, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the width of said hinge (D3) is between about 1/16 inch and 3/32 inch. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have the width of said hinge (D3) to be between about 1/16 inch and 3/32 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further or closer away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 75, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above and further discloses that said first hinge (e) is between said second throat (c) and said bending slot, and said third jaw (b) clamps onto said wall (22) of said gutter (4) upon insertion and rotation of a bending tool in said bending slot per the modification in claim 63, but does not disclose the width (D6) being the shortest distance between said first throat and said bending slot. However, it would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have disclose the width (D6) being the shortest distance between said first throat and said bending slot, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further or closer away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). The phrase "upon insertion and rotation of a bending tool in said bending slot" is regarded to as functional language and while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See MPEP §2114. Furthermore, the third jaw could perform the function stated above if any tool applies downward pressure.

Regarding claim 76, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the width (D6) is preferably about 15/128 inch. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al.

Art Unit: 3637

to have the width (D6) preferably about 15/128 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further or closer away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 77 and 78, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the ratio of the width (D6) to the width (D5) is between about 1.1 and 2.0, and preferably about 1.5. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have the ratio of the width (D6) to the width (D5) is between about 1.1 and 2.0, and preferably about 1.5, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 79, Stevens already modified by Doussot et al. discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the distance (D8) between said first throat (36) and said second throat (c) is 19/128 inch. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. to have the distance (D8) between said first throat and said second throat to be 19/128 inch, since such a modification would

have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claims 50 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Holbrook (U.S. Patent No. 6,347,780 B1).

Regarding claims 50 and 54, Stevens discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system further including at least one of said jaws being serrated. However, Holbrook in Figure 6 discloses gutter hanger clip including two serrated jaws. Stevens and Holbrook are analogous art because they are pertinent in the problem of clamping the top front wall of the gutter. Therefore, it would have been obvious to a person having ordinary skill in the arts at the time of the applicant's invention to modify the clip of Stevens to include serrations in the third and fourth jaws as taught by Holbrook to provide better retention of the clip when in contact with the gutter surface (Col 3, Ln 9-11 and Ln 45-48).

Claims 51-53 and 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of page 4 of Applicant's Response to Restriction Requirement expressly admitting that Groups 2-7 (Figures 5-12) are "obvious over each other within the meaning of 35 U.S.C. 103."

Regarding claim 51, Stevens discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system including fifth and sixth jaws and a second locking lever adjacent said fifth jaw and joined to said body portion by a second hinge, said second locking lever being adapted to be bent at said second hinge to bring said fifth jaw into a locking position against a vertical wall of said gutter. However, per Applicant's admission in page 4, including fifth and sixth jaws and a second locking lever adjacent said fifth jaw and joined to said body portion by a second hinge would have been obvious in view of Figures 5-11 in the Applicant's disclosure. Furthermore, it has been held that a mere duplication of parts, such as the duplication of the jaws, has no patentable significance unless a new and unexpected result is produced. A duplication of parts is generally recognized as being within the level of ordinary skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1955).

Regarding claims 52 and 53, Stevens already modified by Figures 5-11 of the Applicant's disclosure, discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system including a third throat portion between said fifth and said sixth jaws and wherein the shortest distance (D4) between said first throat and said third throat is between about 1/8 and 7/16 inch, preferably about 5/16inch. However, per Applicant's response in page 4, including a third throat portion between said fifth and said sixth jaws and wherein the shortest distance (D4) between said first throat and said third throat is between about 1/8 and 7/16 inch, preferably about 5/16inch would have been obvious in view of Figures 5-11 in the Applicant's disclosure. Furthermore, it has been held that a mere duplication of parts has no patentable significance unless a

new and unexpected result is produced. A duplication of parts is generally recognized as being within the level of ordinary skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1955). Moreover, it would have been an obvious matter of design choice to modify the clip of Stevens already modified by Figures 5-11 of the Applicant's disclosure to have the shortest distance (D4) between said first throat and said third throat to be between about 1/8 and 7/16 inch, preferably about 5/16 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 57 and 58, Stevens already modified by Figures 5-11 of the Applicant's disclosure discloses a gutter-cover system as discussed above but does not disclose a gutter-cover system including a third throat and wherein a second hinge having a width (D2) is formed between said third throat and said third jaw, said second hinge and wherein the width (D2) of said second hinge is between about 1/16 inch and 5/32 inch, preferably about 3/32 inch. However, per Applicant's response in page 4, including a third throat and wherein a second hinge having a width (D2) is formed between said third throat and said third jaw, said second hinge and wherein the width (D2) of said second hinge is between about 1/16 inch and 5/32 inch would have been obvious in view of Figures 5-11 in the Applicant's disclosure. Furthermore, it has been held that a mere duplication of parts has no patentable significance unless a new and

Art Unit: 3637

unexpected result is produced. A duplication of parts is generally recognized as being within the level of ordinary skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1955). Moreover, it would have been an obvious matter of design choice to modify the clip of Stevens already modified by Figures 5-11 of the Applicant's disclosure to have the width (D2) of said second hinge to be between about 1/16 inch and 5/32 inch, preferably about 3/32 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 59 and 60, Stevens already modified by Figures 5-11 of the Applicant's disclosure, discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the ratio of the hinge-width (D2) to the thickness (D) of said body portion is between about 0.25 and 1.2 inch, preferably about 0.94 inch. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Figures 5-11 of the Applicant's disclosure to have the ratio of the hinge-width (D2) to the thickness (D) of said body portion to be between about 0.25 and 1.2 inch, preferably about 0.94 inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further or closer away from the front of the gutter wall while being able to support more length of the gutter cover. A change in size

is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Claims 49 and 70-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Doussot et al. and in further view of page 4 of Applicant's Response to Restriction Requirement expressly admitting that Groups 2-7 (Figures 5-12) are "obvious over each other within the meaning of 35 U.S.C. 103."

Regarding claim 49, Stevens already modified by Doussot et al. discloses the gutter-cover system as discussed above but does not disclose the gutter-cover system further including a recess in said third jaw for accommodating an unlocking tool for pivoting said locking lever about said hinge to move said third jaw out of engagement with said gutter. However, per Applicant's response in page 4, including a recess in said third jaw would have been obvious in view of Figures 8 and 9 in the Applicant's disclosure for accommodating an unlocking tool for pivoting said locking lever about said hinge to move said third jaw out of engagement with said gutter.

Regarding claim 70, Stevens already modified by Doussot et al. discloses the gutter-cover system as discussed above but does not disclose the gutter-cover system further including fifth and sixth jaws and a third throat located therebetween, said third throat being adapted to engage a vertical wall of said gutter between said fifth and sixth jaws; a second locking lever formed between said fourth and fifth jaws and joined to said body portion by a second hinge, said second locking lever being adapted to be rotated so that said vertical wall of said gutter is engaged between said fifth and

sixth jaws. However, per Applicant's response in page 4, including fifth and sixth jaws and a third throat located therebetween, said third throat being adapted to engage a vertical wall of said gutter between said fifth and sixth jaws; a second locking lever formed between said fourth and fifth jaws and joined to said body portion by a second hinge, said second locking lever being adapted to be rotated so that said vertical wall of said gutter is engaged between said fifth and sixth jaws would have been obvious in view of Figures 5-11 in the Applicant's disclosure. Furthermore, it has been held that a mere duplication of parts has no patentable significance unless a new and unexpected result is produced. A duplication of parts is generally recognized as being within the level of ordinary skill in the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1955).

Regarding claim 71, Stevens already modified by Doussot et al. and by Figures 5-11 of the Applicant's disclosure, discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the width (D7) of said second hinge is preferably about fraction $11/128$ inch. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. and by Figures 5-11 of the Applicant's disclosure to have the width (D7) of said second hinge to be preferably about fraction $11/128$ inch, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 72 and 73, Stevens already modified by Doussot et al. and by Figures 5-11 of the Applicant's disclosure, discloses a gutter-cover system as discussed above but does not disclose the gutter-cover system wherein the distance between the first and second throats is (D8) and the width of said second hinge is (D7) and the ratio of (D8) to (D7) is between about 1.1 and 2.0, preferably about 1.5. It would have been an obvious matter of design choice to modify the clip of Stevens already modified by Doussot et al. and by Figures 5-11 of the Applicant's disclosure to have the ratio of (D8) to (D7) to be between about 1.1 and 2.0, preferably about 1.5, since such a modification would have involved a mere change in the size of the components and would allow the clip to be used with gutters whose covers are spaced further, closer, higher, or lower away from the front of the gutter wall. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Elko et al. (U.S. Patent No. 4,455,791 A), a gutter cover clip with channels for receiving gutter wall and gutter cover; Sweet (U.S. Publication No. 2002/0069594 A1), a clip for attaching a gutter cover without the use of screws.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine T. Cajilig whose telephone number is (571) 272-8143. The examiner can normally be reached on Monday - Friday from 9am - 5pm.

Art Unit: 3637

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571)272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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CTC 
9/22/06

LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

